

REMARKS

In order to comply with the requirements of 37 CFR §1.143, applicant must make a provisional election of one invention for prosecution. However, the Office Action withdrew claims 1-8 and 10-15 from consideration, the only claims remaining in the application to be elected.

Applicant respectfully traverses the action and the premise of the restriction requirement.

Claims 1-8 and 10-15 are not newly submitted claims. These claims were originally elected as a result of the restriction requirement of March 2, 2005 requiring restriction between five different sets of claims.

In March of 2005, claims 1-15 were characterized by the Office Action as drawn to a method and system for displaying paint colors on sample cards, classified in class 715, subclass 810. Class 715 is generally directed to data processing wherein "human perceptible elements of electronic information (i.e., text or graphics) are gathered and associated, created, formatted, edited, prepared or otherwise processed in forming a unified collection of such information storable as a distinct entity. . ."

The Examiner characterized claims 1-15 as being drawn to a method and system for displaying selected paint colors on sample cards without clearly indicating that he was considering the claims to be limited to computer graphics, as required by the class and subclass in which he placed these claims.

Applicant respectfully submits that the initial classification of claims 1-15 in a computer data processing class was in error and is contrary to the express recitation of the claims when viewed in the context of the specification.

Original independent method claim 1 recites a method for displaying color samples comprising selecting a plurality of paint colors, placing the selected paint colors on a plurality of sample cards and arranging the sample cards on a display unit. Original independent apparatus claim 8 recites a color display unit having a card display with a plurality of columns and rows, a first plurality of paint sample cards arranged along the first column of the card display, and a second plurality of paint sample cards arranged within the first column and adjacent to a first plurality of sample cards.

None of the original claims 1-15 recite a data processing system, or computer, or any method to be performed by a computer or software. When the claims are read in light of the specification, as required, it is clear that a computer process or computer system is not contemplated and is not being claimed.

The specification in the description of related art [0002] states “When selecting paints, it is often useful to display the paint colors available on color cards. Each card typically provides a color sample for a single paint color.” Furthermore, these cards are “. . . organized and displayed in such a way that the customer is able to find the desired color(s) with relative ease. Additionally, it would be helpful if the card arrangement could also ‘suggest’ other colors to the customer that would go well with a selected color.”

In the summary of the invention [0003], the specification states that “Paint color sample cards are arranged on a two-dimensional display surface such that colors have a similar hue angle, or colors that lie within a hue range, are characterized or grouped together (e.g., along a column) as a family of colors.” And, in paragraph [0004], the summary of the invention points out the physical nature of these cards when it states “Combination style cards may be provided within each color family. The combination style cards may include one or more color schemes

having one or more colors found in the color family in which the combination style card is placed. . . In one embodiment, the combination style card is a tri-fold card including three different color schemes.”

The figures of the application clearly show the physical manifestation of the display (Figure 4) and the color cards (Figures 5-11).

In order not to mislead a careless reader into believing that the specification is talking about a computer system or program, the specification specifically points out in paragraph [0014] “In the following description, certain terminology is used to describe certain features of one or more embodiments of the invention. For instance, a paint color ‘display’ includes any cabinet, counter, advertising panel, cardholders, etc. and combination thereof that may be used to exhibit paint color samples for customers or shoppers.” The “display” recited by the claims is a cardholder for holding physical paint color samples for customers or shoppers, to remove from the cardholder and take with them.

As the specification points out in paragraph [0015], “One aspect of the present invention provides a method for systematically arranging paint color samples for convenient browsing, identification, and/or selection of desired colors by shoppers.”

To drive home the physical nature of the cards themselves, the specification again describes in paragraph [0017] a certain kind of color card, “In one implementation of the invention, the combination style card is a tri-fold card including three different color schemes.”

The specification refers in paragraph [0031] to the paint color display shown in Figure 4, which is clearly a two-dimensional physical cardholder containing rows and columns of physical sample paint cards.

In paragraph [0035], the physical characteristics of the tri-fold card are described. “Another feature of the invention provides for a plurality of combination style cards to be displayed along each column 402-414. Combination style cards are used to provide color scheme ideas to shoppers for some of the colors in the color display. In one implementation of the invention a combination style card is a tri-fold card including three different color schemes.”

The specification, paragraph [0036] goes on to describe that these cards are “laid out at particular locations (e.g., the beginning of one or more rows) along one or more columns of the color display.” This display, as defined earlier, is a cardholder.

The specification specifically describes a variety of paint sample cards that can be used with the color display illustrated and described. Paragraph [0039] describes paint sample cards shown in Figure 5. The physical nature of the paint sample card of Figure 5 is clearly brought home by Figure 6, which is the back side of the paint sample card of Figure 5, as described in paragraph [0043] of the specification.

The specification then goes on to describe the various physical sample cards illustrated in Figures 7-11. In paragraph [0046] the sample cards shown in Figures 8-11 are described as “. . . tri-fold combination style cards include three color schemes and a corresponding sample room for each color scheme.”

The physical nature of the sample cards and the card display that holds these cards as recited in the claims and the specification seems readily apparent.

In the first Office Action of March 28, 2005 after election, the elected claims were rejected as anticipated by the Microsoft PhotoDraw 2000 software program.

In response, on November 1, 2005, applicant strenuously objected that the prior art reference fails to teach “. . . the invention of arranging a plurality of physical paint sample cards in a two-dimensional display as claimed.”

In the second and final Office Action of March 17, 2006, it was asserted that applicant's arguments had been fully considered but were not persuasive. The Office Action specifically pointed out “Firstly, the specific element of the paint sample cards being ‘physical’ is not seen within the claims. It is noted that the features upon which applicant relies (i.e., ‘physical paint sample cards’) are not recited in the rejected claim(s).”

The Office Action went on to state that Accordingly, the PhotoDraw program can be interpreted as having paint sample cards.

Applicants took this as a clear invitation to include the word “physical” in the claims.

Along with a Request for Continued Examination of August 11, 2006, applicant specifically amended the claims to recite “A method for displaying paint color samples in a two-dimensional physical display unit, comprising. . . placing the selected plurality of paint colors on a first plurality of physical paint color sample cards with one color on each physical sample card.”

Applicant added the word “physical” into the claims. Not because he deemed it was necessary to clearly define the invention as comprising a physical card display with physical cards being held by the display, but because of the invitation in the Final Office Action of March 17, 2006. Applicant still maintains that the claims clearly recite physical structure, and not a computer system or computer software even without the addition of the word “physical.”

On September 25, 2006, applicant received a second restriction requirement which withdrew all the amended claims 1-8 and 10-15 in the application from consideration, as being

drawn to a non-elected invention, because, as stated in the Office Action "Since the amendment now defines the sample cards as 'physical paint color sample cards' (which was not the case in view of the originally filed claims)."

The result of withdrawing claims 1-8 and 10-15 leaves applicant with no claims left for examination.

Applicant respectfully requests reconsideration of this restriction requirement, on the grounds that the originally filed claims 1-15 are clearly directed to a physical system for holding physical sample cards, as described and defined in the specification. At the very least, defining the word "display" in the specification to mean cardholder prevents "display" as used in the claims from meaning a computer screen.

Applicant respectfully requests that the restriction requirement be withdrawn and amended claims 1-8 and 10-15 be appropriately examined and allowed, and this application passed to issue.

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Signature

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Very truly yours,

SNELL & WILMER L.L.P.



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